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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MING TA HSU, GRACE LIN, CHO YI HUANG, JEFFREY
BUNCE, JYH-HWA CHEN, and HSIN-NIEN CHEN

Appeal 2008-6275
Application 10/712,880
Technology Center 3600

Decided:¹ March 30, 2009

Before HUBERT C. LORIN, DAVID B. WALKER, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Ming Ta Hsu, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 4-12, 14-20, and 22-34. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention is a method and system for linking a product manufacturing facility, such as a semiconductor foundry, to one or many quotations. (Specification [0017].) The system includes a quotation database, which stores information about quotes provided to a customer. (Specification [0018].) A product database stores information about products and the technologies on which the product is built. (Specification [0021].) A mapping database associates the quotation price and other information with product name. (Specification [0022].)

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method for linking a semiconductor product manufacturing facility order with a quotation, the method comprising:
receiving the quotation including at least a first product and its quote amount;

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Sep. 11, 2006) and Reply Brief ("Reply Br.," filed Jan. 4, 2008), and the Examiner's Answer ("Answer," mailed Nov. 26, 2007).

storing the quote amount associated with the first product in a quotation database;

storing predetermined information associated with the first product in a product database;

updating a mapping database record associated with the first product with the predetermined information from the quotation database and the product database associated with the first product, wherein the mapping database associates information of the quotation from the quotation database with information of the first product from the product database;

receiving the product manufacturing facility order that identifies at least the first product and desired quantity;

retrieving a mapping database record associated with the first product from the mapping database; and

calculating an order price based on the mapping database record comprising the quote amount associated with the first product, and the desired quantity identified in the product manufacturing facility order.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Shavit	US 4,799,156	Jan.17, 1989
Senior	US 2002/0029171 A1	Mar. 7, 2002
Banks	US 2002/0161672 A1	Oct. 31, 2002

The following rejections are before us for review:

1. Claims 1, 2, 4-12, 14-20, and 22-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shavit in view of Banks.

2. Claims 32-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shavit in view of Banks and Senior.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 2, 4-10, 19, 20, and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Shavit in view of Banks. The issue turns on whether one of ordinary skill in the art would have been led by Shavit and Banks to a mapping database comprising quotation information from a quotation database or a quote amount.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites a method including the step of
updating a mapping database record associated with the first product with the predetermined information from the quotation database and the product database associated with the first product, wherein the mapping database associates information of the quotation from the quotation database with information of the first product from the product database.
2. Claim 1 recites “retrieving a mapping database record associated with the first product from the mapping database.”

3. Claim 1 also recites “calculating an order price based on the mapping database record comprising the quote amount associated with the first product, and the desired quantity identified in the product manufacturing facility order.”
4. Claim 11 recites a method including the step of
 updating respective mapping database records in a mapping database with the predetermined information from the quotation database records and the respective product database records associated with the first product and the second product, wherein the mapping database associates information of the quotation from the quotation database with information of the at least two products from the product database.
5. Claim 11 recites “retrieving the respective mapping database records from the mapping database.”
6. Claim 11 also recites “calculating a total order price based on the respective mapping database record comprising the two quote amounts of the at least two products, and their respective desired quantities identified in the product manufacturing facility order.”
7. Claim 19 recites a computer-readable medium with stored instructions for performing the method steps recited in claim 1.
8. Claim 26 recites a system comprising “a mapping database that interfaces with both the quotation database and the product database capable of storing quotation information associated with the first product.”

9. Claim 26 recites “memory connected to the quotation entry device configured to receive a mapping database record associated with the first product from the mapping database.”
10. Claim 26 also recites
a price calculator configured to receive the product manufacturing facility order from the order entry device, to access the memory to identify the quote amount associated with the first ordered product from the mapping database record, and to calculate a price for the first ordered product based on the desired quantity and the quote amount.

The scope and content of the prior art

Shavit

11. Shavit describes a system for interactive on-line electronic communication and processing of business transactions between buyers and sellers. (Col. 2, ll. 16-19.)
12. Shavit’s system includes a menu for each distributor, which includes a catalog. (Col. 12, ll. 58-59.)
13. Shavit’s system includes a procurement process function for a user. (Col. 25, ll. 10-12.)
14. The procurement process function includes a function to make catalog or price inquiries of the distributor’s database. (Col. 26, ll. 29-34.)
15. The procurement process function includes a request for quotation function (RFQ). (Col. 25, ll. 28-30.)

16. In response to an RFQ, a distributor can present the user with a bid, which the user may review or store for later. (Col. 25, ll. 37-41.)
17. The procurement process function includes a purchasing function. (Col. 25, ll. 51-53.)
18. With the purchasing function, a buyer can convert an outstanding RFQ to an order. (Col. 25, ll. 58-62.)

Banks

19. Banks describes a system for supporting commercial transactions by synchronizing e-Catalog data into a users ERP system to reduce rogue buying practices that lead to purchases with incorrect pricing. (Banks [0005].)
20. Banks describes the e-catalog vendor unit 13 consolidating product information from multiple suppliers and maintains current product pricing. (Banks [0014].)
21. Banks describes a purchasing system 17 receiving daily data updates of e-catalog 13 database data. (Banks [0017].)
22. Banks describes system 31 synchronizing price, vendor, product and other information between the unit 13 and 17 databases once a Catalog file from the e-Catalog unit 13 is received and loaded into a set of cross reference (data mapping) tables in the unit 17 database. (Banks [0019].)
23. Banks describes purchasing system 17 using the updated information to generate a purchasing order to send to a supplier. (Banks [0028].)

Senior

- 24. Senior describes an electronic purchasing system. (Senior [0001].)
- 25. Senior describes using a wireless PDA to communicate in the electronic purchasing system. (Senior [0063].)

Any differences between the claimed subject matter and the prior art

- 26. Shavit does not describe a mapping database.
- 27. Banks does not describe quote information from a quotation database in a mapping database record.

The level of skill in the art

- 28. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of electronic commerce. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

- 29. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the

prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1, 2, 4-10, 19, 20, and 22-25 under 35 U.S.C. § 103(a) over Shavit in view of Banks.

The Appellants argue claims 1, 2, 4-10, 19, 20, and 22-25 as a group (App. Br. 17). We select claim 1 as the representative claim for this group, and the remaining claims 2, 4-10, 19, 20, and 22-25 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007). (App. Br. 17.)

The Appellants argue that the Examiner has failed to present a prima facie showing of obviousness in rejecting claim 1

[s]ince neither Shavit nor Banks discloses or suggests a mapping database that comprises quotation information from a quotation database, one of ordinary skill in the art would not have been led to include a mapping database record that comprises a quote amount from the quotation database when calculating an order price.

(App. Br. 15.) The Appellants argue that neither the e-Catalog 13 nor the Purchasing System 17 of Banks corresponds to the claimed mapping database. (App. Br. 13.) The Appellants contend that the e-Catalog 13

merely contains product information and pricing and contract terms (App. Br. 13) and Purchasing System's cross reference tables merely contain updated product information (App. Br. 13-14).

The Examiner cites Shavit for teaching the steps of storing product information in a product database and a quote amount in a quotation database and using the information to calculate order pricing. (Answer 6.) However, the Examiner admits that Shavit does not disclose the claimed steps which include a mapping database. (Answer 7-8.) The Examiner cites Banks for teaching a mapping database, having product information and associated price. (Answer 8.) The Examiner states that associated pricing information comprises the amount quoted and, therefore, is quotation information. (Answer 12.) The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Shavit to include a mapping database as taught in Banks, "in order to improve the responsiveness of the system to purchasers and thereby increase commerce using the method." (Answer 9.)

The Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *Id.* at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* at 1739. The operative question in this "functional approach" is "whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR* at 1740.

We find that one of ordinary skill in the art would be led by the combination of Shavit and Banks to a mapping database having quotation information from a quotation database. We find that Shavit describes a quotation database having quotation information (i.e., saved quotes) (FF 16) and that Shavit uses the quotation information to create a purchase order (FF 18). Shavit also describes a product database (i.e., catalog). (FF 12.)

We find that Banks teaches providing a mapping database (i.e., database in purchasing system 17) to create a purchasing order. The mapping database in Banks contains information about products and their associated prices (FF 20-21) and is used to create a purchase order (FF 23). The mapping database is synchronized with an e-Catalog database, which contains information from multiple suppliers, to update product information and prices. (FF 20.)

We find that to apply Bank's teaching of providing a mapping database which synchronizes with another database to the system in Shavit, which has both a quotation database and a product database, would be no more than the predictable use of prior art elements according to their established functions. The combined system would have a mapping database that is updated with information from the product database and the quotation database of Shavit and that contains a mapping database record with quotation information and associated product information. The mapping database record would be retrieved and used to calculate an order price when creating a purchase order, as described in Shavit.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 1. Accordingly, the rejection of claims 1, 2, 4-10, 19, 20, and 22-25 is affirmed.

The rejection of claims 11, 12, and 14-18 under 35 U.S.C. § 103(a) over Shavit in view of Banks.

The Appellants argue claims 11, 12, and 14-18 as a group (App. Br. 18). We select claim 11 as the representative claim for this group, and the remaining claims 12, and 14-18 stand or fall with claim 11. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants again argue that the Examiner has failed to present a prima facie showing of obviousness in rejecting claim 11 since the prior art references fail to disclose or suggest the claimed steps pertaining to a mapping database. Appellants' state "[a]s discussed above, Banks fails to disclose or suggest a mapping database that associates information of quotation from a quotation database with product information from a product database." (App. Br. 17.)

We note that the method of claim 11 is similar to the method of claim 1 except claim 11 pertains to at least two products and quotations instead of one. As with claim 1 above, we find that the combination of Shavit and Banks results in the claimed steps pertaining to a mapping database.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 11. Accordingly, the rejection of claims 11, 12, and 14-18 is affirmed.

The rejection of claims 26-31 under 35 U.S.C. § 103(a) over Shavit in view of Banks.

The Appellants argue claims 26-31 as a group (App. Br. 19). We select claim 26 as the representative claim for this group, and the remaining

claims 27-31 stand or fall with claim 26. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants again argue that the Examiner has failed to present a prima facie showing of obviousness in rejecting claim 26 since the prior art references fail to disclose or suggest the elements pertaining to a mapping database. The Appellants state Banks fails to disclose or suggest “a mapping database that interfaces with both the quotation database and the product database capable of storing quotation information associated with the first product.” (App. Br. 18.)

As discussed above with regards to claim 1, we find that the combination of Shavit and Banks results in a mapping database, having quotation information associated with a first product, that synchronizes with a quotation database and a product database.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 26. Accordingly, the rejection of claims 27-31 is affirmed.

The rejection of claims 32-34 under 35 U.S.C. § 103(a) over Shavit in view of Banks and Senior.

The Appellants argue claims 32-34 as a group (App. Br. 19). We select claim 32 as the representative claim for this group, and the remaining claims 33-34 stand or fall with claim 32. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that the combination of Shavit, Banks, and Senior does not teach the missing limitations of claim 26. (App. Br. 19.) Claims 32-24 depend from claim 26. However, we found above that the

combination of Shavit and Banks led one of ordinary skill in the art to the limitations of claim 26.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claims 32-24. Accordingly, the rejection of claims 32-24 is affirmed.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1, 2, 4-12, 14-20, and 22-31 under 35 U.S.C. § 103(a) as unpatentable over Shavit in view of Banks and claims 32-34 under 35 U.S.C. § 103(a) as unpatentable over Shavit in view of Banks and Senior.

DECISION

The decision of the Examiner to reject claims 1, 2, 4-12, 14-20, and 22-34 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 2008-6275
Application 10/712,880

hh

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